

PTO/SB/21 (09-04)

Approved for use through 07/31/2006. OMB 0651-0031  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**TRANSMITTAL  
FORM**

(to be used for all correspondence after initial filing)

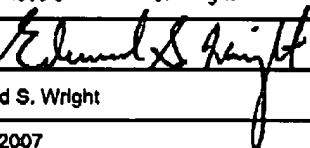
Total Number of Pages in This Submission

Application Number	10/766,754	<b>RECEIVED</b> <b>CENTRAL FAX CENTER</b> <b>MAR 05 2007</b>	
Filing Date	01/27/2004		
First Named Inventor	Andrew Perkins		
Art Unit	3721		
Examiner Name	Thanh K. Truong		
Total Number of Pages in This Submission	5	Attorney Docket Number	A-75001

**ENCLOSURES (Check all that apply)**

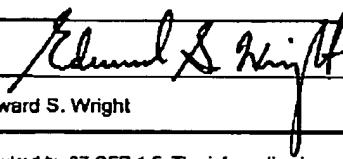
<input type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> After Allowance Communication to TC
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Amendment/Reply	<input type="checkbox"/> Petition	<input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Power of Attorney, Revocation	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Change of Correspondence Address	<input type="checkbox"/> Other Enclosure(s) (please identify below):
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Terminal Disclaimer	
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> Request for Refund	
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> CD, Number of CD(s) _____	
<input type="checkbox"/> Reply to Missing Parts/ Incomplete Application	<input type="checkbox"/> Landscape Table on CD	
<input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53		
Remarks		

**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

Firm Name	Law Offices of Edward S. Wright		
Signature			
Printed name	Edward S. Wright		
Date	03/05/2007	Reg. No.	24,903

**CERTIFICATE OF TRANSMISSION/MAILING**

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

Signature			
Typed or printed name	Edward S. Wright	Date	03/05/2007

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

A-75001

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE****RECEIVED  
CENTRAL FAX CENTER****MAR 05 2007**

In re application of:

Andrew Perkins

Serial No. 10/766,754

Filed: January 27, 2004

For: **METHOD AND APPARATUS FOR  
PRE-TEARING STRINGS OF  
AIR-FILLED PACKING MATERIAL  
AND THE LIKE**Examiner: Thanh K. Truong  
Group Art Unit: 3721

Confirmation No. 2266

March 5, 2007

**REPLY BRIEF**

Edward S. Wright  
1100 Alma Street, Suite 207  
Menlo Park, CA 94025  
(650) 330-0830 (Telephone)  
(650) 330-0831 (Facsimile)

RECEIVED  
CENTRAL FAX CENTER

MAR 05 2007

Applicant responds as follows to the new points of argument made in the Examiner's Answer.

#### Hindsight Reconstruction - Lack of Motivation

Contrary to the Examiner's suggestion, applicant is not attacking the individual merits of the references, but rather the lack of motivation or suggestion in any of them for combining selected features from them as the Examiner has done.

The claims on appeal are directed to apparatus and a method for making a string of air-filled packing cushions with partially pre-torn rows of perforations between the chambers to facilitate tearing a desired number of cushions from the string. In rejecting these claims, the Examiner cites Fuss et al. as showing a apparatus and a method for making perforated strings of air-filled packing cushions. However, as the Examiner has acknowledged, Fuss et al. does not disclose or even remotely suggest pre-tearing the string of inflated cushions along the rows of perforations to facilitate separation of the cushions by the user.

To overcome that shortcoming, the Examiner cites Bolton which is not concerned with air-filled packing cushions, but rather with a method of making strings of plastic bags which can be fed to a loading station as multibag units arranged in a shingled or imbricated configuration so that all of the bags in a unit can be loaded at once. This is said to provide a more rapid and economic operation for loading articles into the bags than supplying the bags one at a time to the loading equipment.

There is no motivation in the references themselves or elsewhere in the prior art for combining the selected features of Fuss et al. and Bolton in the manner suggested by the Examiner. That motivation comes entirely from applicant's own disclosure and claims. As noted above, Fuss et al. is concerned with making strings of air-filled packing cushions, and it does not even remotely suggest pre-tearing the string of inflated cushions along the rows of perforations to facilitate separation of the cushions by the user. Bolton is concerned with a method of making strings of plastic bags which can be fed to a loading station as multibag units arranged in a shingled or imbricated configuration so that all of the bags in a unit can be loaded at once. The fact that it may use rollers for tearing the bags apart in that particular application does not suggest the pre-tearing of a string of inflated packing cushions to facilitate separation of the cushions by the user.

The Examiner suggests that the combination would make a packaging system which is capable of more rapid and economic operation. That statement appears to have

been taken from Col. 1, lines 35 - 41 of Bolton, and it appears to have been taken out of context. The full statement in Bolton is as follows:

The present invention aims to provide means for making a packaging system which is capable of more rapid and economic operation for loading articles into bags which are fed to a loading station in the form of a sequence of bags. Such system is intended to enable the packaging operation to be speeded up in subsequent vacuumizing and sealing steps as well. [Col. 1, lines 35 - 41.]

This has no application to the partial pre-tearing of a string of inflated packing cushions to facilitate separation of the inflated cushions.

In his Answer, the Examiner cites Fuss et al. as teaching transversely extending rows of perforations which provide means for tearing the cushions apart and Bolton as teaching means for partially separating bags at lines of perforation. From that he concludes that one skilled in the art would have seen the benefit of combining the two references to partially separate the "bags" as taught by Bolton. That, however, overlooks the fact that there is no teaching in either reference or elsewhere in the known art of the desirability of pretearing strings of inflated packing cushions or the means for doing so. That critical teaching comes from applicant's own disclosure and applicant's disclosure alone. The fact that the Examiner referred to the partial separation of "bags" and not air-filled cushions underscores the fallacy in his position. The simple fact is that the references do not even remotely suggest the combination proposed by the Examiner.

#### Pre-Tearing Strings of Inflated Cushions

The Examiner's argument that applicant's invention pre-tears a flat portion of the string of inflated cushions, rather than making the tear directly between the cushions, misses the mark, and the fact that the pre-tearing is done to one side of the cushions is further evidence of the unobviousness of the invention and the shortcomings of the references.

As pointed out in applicant's opening brief, the tearing mechanism shown in Bolton cannot simply be combined with the machine shown in Fuss et al. to provide a workable system for pre-tearing strings of inflated cushions. The rollers shown in Bolton for tearing the bags into the multibag units are quite different than the rollers which do the pre-tearing in applicant's invention. Bolton shows two sets of rollers 63A, 63B, etc. and 64A, 64B which are mounted on pivot arm 62 and on another (unnumbered) arm for movement selectively into engagement with different parts of the material to tear the bags apart. This requires a relatively complex mechanism with moving parts and actuators which are not required in applicant's invention. Some of the rollers engage the central portion

of the film material, and while that can be done with an uninflated material, it cannot be done with an inflated material such as a string of air-filled packing cushions. Combining the teachings into an operable system would, therefore, require substantial modification of Bolton to avoid contact with the inflated cushions, and that in itself is beyond the scope of obviousness.

#### **Meschi - Still More Hindsight Reconstruction**

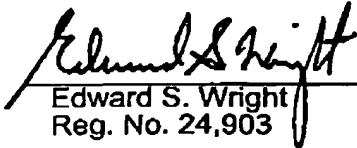
The Examiner cites Meschi as showing a tear roller which has an arcuate section and a section adjacent to the arcuate section which remains out of driving engagement with the material, a feature acknowledged by the Examiner not to be found in Fuss et al. and Bolton. Meschi, however, is not concerned with air-filled packing cushions or the loading of multibag units of plastic bags, but rather with yet a third unrelated technology in the cutting and stacking of paper sheets. The elements (125, 126) characterized by the Examiner as tear rollers do not rotate continuously, but turn only when it is desired to sever the material, and when they do turn, the material is completely severed rather than being only partially torn as in applicant's invention.

There is no motivation whatsoever for combining the teachings of Meschi with those of Fuss et al. and Bolton, and the proposed combination is based entirely on impermissible hindsight and applicant's own disclosure and claims. In an effort to create such motivation, the Examiner refers to a portion of Meschi that says the rollers provide an efficient means to periodically cause a substantial tensioning on the material sheet to produce a tearing at the transversal pre-pierced straight line, then argues that it would have been obvious to modify Fuss et al. to incorporate such a roller to provide a similar result. That, however, once again overlooks the fact that there is no teaching in the references or elsewhere in the known art of the desirability of pretearing strings of inflated packing cushions. As noted above, that critical teaching comes from applicant's own disclosure and applicant's disclosure alone.

#### **SUMMARY AND CONCLUSION**

It is once again respectfully submitted that the rejections which the Examiner has made cannot be sustained and that the action of the Examiner should be reversed.

Respectfully submitted,

  
Edward S. Wright  
Reg. No. 24,903

(650) 330-0830